

REMARKS/ARGUMENTS

Claims 25-27, 29-35, 37-43, 45-51 and 53-66 are pending in this application. Claims 25-27, 29-32, 31-43 and 45-48 stand rejected while claims 33-35, 37-40, 49-51 and 53-56 have been withdrawn by the Examiner from further consideration as being directed to [a] non-elected invention(s). Reconsideration is respectfully requested based on the remarks presented below.

Request for Reconsideration Re: Restriction Requirement

The Examiner stated at p. 3 of the Office Action that the Restriction Requirement of Groups II and IV-XIV is still deemed proper and is therefore made final. In response, applicants respectfully urge the Examiner to reconsider her decision to the extent that it includes a finding that claim Groups II and IV constitute separate inventions from Groups I/ III. That is, for the reasons given below applicants submit that Groups II and IV relate to the same general inventive concept as Groups I/III in that all four Groups (I-IV) contain the same or a corresponding special technical feature which is neither taught nor suggested in the cited prior art.. Therefore, applicants respectfully contend that the claims of Groups II and IV should be examined together with those of Groups I/III such that the claims of Groups I-IV should all be examined together.

Applicants agree with the statement at the bottom of p. 2 of the Office Action that the expression, “special technical features” means those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. Applicants strongly disagree, however, with the Examiner’s contention that, “the special technical feature that links the Groups is [only] the (C1-C20) dialkyl ketone peroxides” Applicants, instead, contend that the Examiner has construed the ‘special technical feature’ recited in the claims of each of Groups I-IV too narrowly. That is, each of the independent claims (nos. 25, 33, 41 and 49) of Groups I-IV, respectively, not only recites that the agent comprises, as the only active component, at least one material selected from the group consisting of (C1-C20) dialkyl ketone peroxides and all of their possible isomers; they also recite that the active component is present in a percentage by volume of less than or equal to 5%. Thus, the special technical feature is comprised of both features, i.e., (1) the (C1-C20) dialkyl ketone peroxides and that the active

components (peroxides/isomers) are present in a percentage by volume of less than or equal to 5%. As demonstrated below, when the special technical feature is properly defined in accordance with the explanation above, it is neither taught nor even suggested by the prior art cited by the Examiner.

Regarding the references cited in the present Office Action, i.e., JP-A-6 321 711 (hereinafter "D1") and EP-A-0 775 439 (hereinafter "D2"), applicants respectfully submit that the claims as amended entirely distinguish the compositions used in the methods recited therein over both of the cited references. More particularly, JP-A-6 321 711 ("D1") describes a germicide containing the combination of iron phthalocyanine and an organic peroxide. Amended claims 25, 33, 41 and 49 are distinguishable, however, over the disclosure contained in D1 in that the agents as recited in the subject claims are not a combination as disclosed in the subject reference. The reference does not teach, or even suggest, the agent as recited in applicants' claims.

EP-A-0 755 439 ("D2"), on the other hand, discloses the use of a composition comprising from 12% to 70% of a dialkyl (C1-C6) ketone peroxide for the preservation and anatomical preservation of dead organic tissues of animal or human origin. Amended claims 25, 33, 41 and 49 are distinguishable over the disclosure contained in D2 due to their recitation that the concentration of the active agent, as recited in the subject claims, is less than or equal to 5% (by volume). This feature is neither taught nor even suggested in D2. The subject reference is further discussed below in the portion of this response dealing with applicants' traversal of the claim rejection(s) under 35 U.S.C. 103.

In summary, therefore, applicants respectfully submit that claim Groups I - IV are all linked together by a corresponding special technical feature not taught or suggested by D1 and/or D2. Thus, claims 25-56 are believed to relate to a single general inventive concept under PCT Rule 13.1. As such, applicants respectfully request the Examiner to reconsider the finality of the restriction requirement insofar as it includes a finding that claim Groups II - IV are directed to different inventions than combined Groups I/III and to examine all of the claims of Groups I-IV (nos. 25-56) together in the present application.

Claim Rejections Under 35 U.S.C. §103

On p. 4 claims 25-27, 29-32, 41-43 and 45-48 are rejected under 35 U.S.C. 103 over EP 0 775 439 ("D2"). The rejection is respectfully traversed for the reasons provided below.

Reference (D2) is taken as the closest prior art to the presently claimed method in that it discloses a method for preserving organic tissues against the natural decomposition process and contamination with fungi wherein the process utilizes, as the only active ingredient, a (C1-C6) dialkyl ketone peroxide, without the need for a high temperature or a catalyst for its activation. However, as developed further below the effective percentage of the active ingredient employed within the method is significantly higher than the claimed 5% by volume. The reference, furthermore, contains no teaching or suggestion to reduce the amount of the active component to a concentration within the claimed range, and thus it neither teaches nor even suggests applicants' method as presently claimed.

In particular, as indicated above the reference discloses the use of these compositions to prevent contamination by fungi and to preserve tissues against rotting due to the action of microbial agents (see paragraph [0001] and Examples 5, 6, and 9-12). However, the reference does not disclose for this purpose to use a composition comprising a single (C1-C20) dialkyl ketone peroxide in a percentage less than or equal to 5% by volume as presently claimed. Rather, D2 teaches to use a composition comprising one (C1-C6) dialkyl ketone peroxide, preferably methyl ethyl ketone peroxide, in a proportion of 12-70% by volume (see, e.g., paragraph [0022] on p. 3 of the specification). Furthermore, each of the examples provided in D2 disclose the inclusion of a percentage of active component, i.e., 60%, 50%, 40% and 35%, i.e., which are significantly higher than the lowest volume (i.e., 12%) disclosed for use by the reference as indicated above and, thereby, also significantly higher than the range (less than or equal to 5% by volume) that is recited in applicants' claims..

While applicants recognize that the disclosure of D2 is not limited to what is contained in the Examples, it is respectfully submitted that the values of 35% and above disclosed for use within the subject Examples clearly would neither teach nor suggest to one having an ordinary level of skill in this art to utilize the low end of the 12-70% volume disclosed by the reference, much less to ignore entirely the teachings contained in the reference by going below 12% by

volume to a volume of less than 5% as recited in applicants' claims. It is an easy matter to allege, notwithstanding the teachings contained in the reference, that one would be motivated to 'optimize' the results described thereby with the use of applicants' claimed range of less than or equal to 5%. However, there is no support for such an interpretation. That is, considering the teaching by the reference of a lower level of 12%, and the fact that the reference exemplifies the method with compositions containing between 35-60% by volume of the active material, applicants respectfully contend that there is no support for the position that one of ordinary skill in this art would find it suggested to use a volume amount of active ingredient of less than or equal to 5%. The reference, in fact, teaches away from using any value less than 12% by volume.

For the reasons set forth above, the Examiner is respectfully requested to reconsider and withdraw the rejection under 35 USC 103 based on EP 0 775 439 (D2).

On p. 7 of the Action claims 25-27 and 41-43 are rejected under 35 U.S.C. 103 over Brankling (WO 97/47708), hereinafter referred to as "D3". The rejection is respectfully traversed.

The Brankling reference (D3) discloses a method of inhibiting the growth of bacteria in hydrocarbon fluid reservoirs wherein the method comprises the addition of a peroxy compound such as methyl ethyl ketone peroxide (see p. 8, line 9). The reference is entirely lacking in any disclosure regarding the concentration of the peroxy compound to be employed. The reference discloses further that peroxy compounds are decomposed in the reservoirs, i.e., leading to the generation of free radicals. Thus, the method requires a thermal decomposition (since the reservoirs are usually at elevated temperatures relative to the ambient temperature (see, e.g., p. 5, lines 17-24 and p. 6, line 27)) in order to produce the active component. Such a thermal decomposition forms no part of applicants' method.

The reference additionally contemplates the necessity of including an additive that inhibits or accelerates the decomposition of the peroxide at temperatures above or below its "self accelerating decomposition temperature" (SADT) that is, according to the temperature used (see p. 7, line 29 to p. 8, line 3 and claims 7 & 8). The use of this additive is also not part of applicants' claimed method. The subject reference additionally teaches the thermal or catalytic decomposition of other peroxy compounds leading to the generation of free radicals having biocidal activity (see, e.g., p. 8, lines 23-25). In summary, therefore, the reference teaches to place

the peroxides in a reservoir heated to a temperature above ambient temperature, in order to generate free radicals that will destroy bacterial cells. This methodology does not teach or even suggest the presently claimed method, however.

Thus, based on the discussion above, the Examiner is respectfully requested to reconsider and withdraw the rejection under 35 USC 103 of claims 25-27 and 41-43 over Brankling, i.e., Ref. D3.

On p. 9 claims 25-27 and 41-43 are also rejected under 35 U.S.C. §103 over Deppe Hans (EP 0 024 304), hereinafter "D4". The rejection is respectfully traversed.

The subject reference discloses a method of disinfecting and sterilizing mattresses and large volume bed textiles that combines a chemical treatment with a thermal treatment utilizing microwaves. Organic peroxides (e.g., ketone peroxides) are one of the many active compounds taught for use in the chemical treatment aspect of the method. The peroxide compounds are then decomposed to form free radicals capable of undertaking the disinfecting and sterilizing effect by raising the temperature of the peroxide to above ambient temperature (see the translation at p. 8). Thus, production of the active material requires, as in the case of D3 discussed above, the temperature to be raised such that the peroxy compound decomposes in order to form the free radicals. This heat-decomposition feature is not part of the method claimed by applicants.

Further to the above, the claims recite that the (C1-C20) dialkyl ketone peroxides (and all of their possible isomers) are the only active component. Example 5 of the subject reference (D4), however, discloses the use of methyl ethyl ketone peroxide, without disclosing any concentration for this active material, in combination with other active ingredients, i.e., hydrogen peroxide and dibenzoyl peroxide - prior to the microwave treatment step. Such a disclosure, therefore, teaches away from the requirement, as recited in each of the rejected claims, that the peroxides or their isomers serve as the only active component.

For the reasons above, therefore, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 25-27 and 41-43 over D4.

Summary

The remarks presented above are believed to overcome all of the grounds for rejection under 35 U.S.C. 103 based on Refs. D2, D3 and D4. The Examiner is, therefore, respectfully requested to reconsider and withdraw all of the claim rejections and to issue a Notice of Allowance for the claims of this case.

If the Examiner does not agree, however, and if she believes that an interview would advance the progress of the application, she is respectfully invited to telephone applicants' representative at the number below so that an interview concerning this case may be arranged.

Respectfully submitted,

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